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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/022,874      | 12/20/2001  | Chika Nakanishi      | 217408US0CONT       | 4217             |

22850 7590 06/10/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

FAN, JANE T

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1625

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

BEST AVAILABLE COPY

**Office Action Summary**

Application N .

10/022,874

Applicant(s)

NAKANISHI ET AL.

Examiner

Jane T. Fan

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 1-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

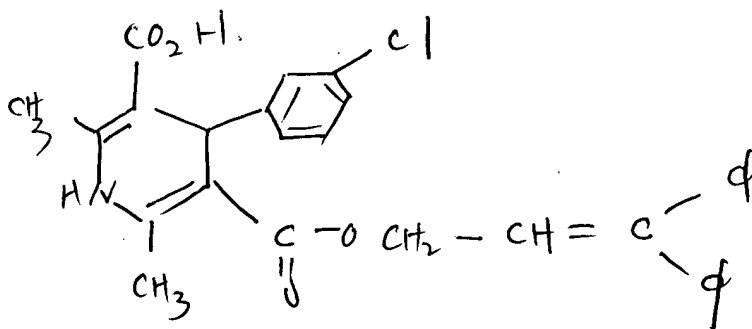
- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ..

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**DETAILED ACTION**

1. Applicant's election with traverse of group I, a single disclosed species of example 12 (the election is appreciated since the undersigned examiner omitted inadvertently) in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the compounds in both groups have a common core. This is not found persuasive because of the following reason:

The gist of applicants' arguments in traversing the restriction requirement appears to be that the essence of the invention is in having a DHP moiety with no criticality existing with respect to other attaching groups. Thus, they are of the opinion that all their heterocyclic groups encompassed in the generic claims represent one invention. If this is so, then there can be no patentability (all 102 rejections) of all the claimed compounds encompassed in the generic claims over the art of record, pat. 6,350,766, WO9849144(11/5/98) which teaches the following compound:

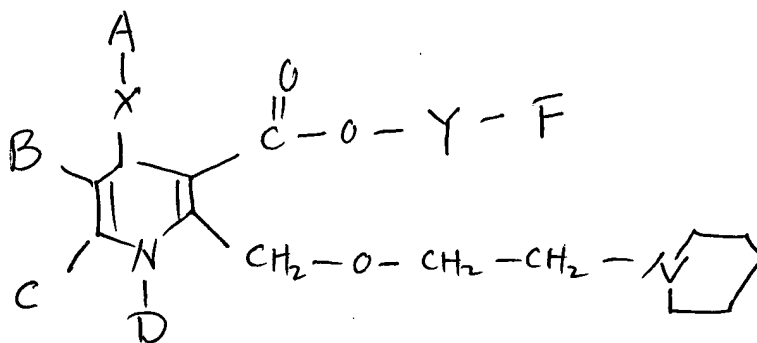


It is noted that there is much greater diversity in structures between the compounds encompassed by the claims than between some of these compounds and the art ones. Therefore, to argue that the compounds represent one inventive concept would be inconsistent with arguments with respect to their patentability over the art.

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The requirement is still deemed proper and is therefore made FINAL.

In view of applicants' election, the following subject matter in claims 1-21 has been searched and examined for merits:



All variables, A, B, C, D, Y, F (formula 4) are as defined in claim 1.

Claims 1-21 are objected to as being drawn to Improper Markush groups. Note the above rationale. Deletion of all non-elected subject matter would overcome this objection.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

1. The phrase “dihydropyridine derivatives” is indefinite. “A dihydropyridine” is suggested.

2. The word “general” is indefinite. Deletion of this word is suggested.

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3. The phrases “heteroaryl group”, “heteroaryl lower alkyl group” are indefinite. It is not known what kind of heteroaryl group is intended. These terms encompass fused ring of twenty or more.

4. Claims 1-7, 10-21 do not read on the elected subject matter. Note the definition of E.

5. The plural term “salts” reads on unsupported mixtures. It should read “a salt”.

6. Claim 20 fail to depend on an earlier claim.

4. Claims 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. If applicants intended to have these claims be composition claim, the claim should recite an effective amount of its intended use and an inert carrier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane T. Fan whose telephone number is 703-308-4705. The examiner can normally be reached on 7:00am-3:30pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4734 for regular communications and 703-308-4734 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Jane T. Fan  
Primary Examiner  
Art Unit 1625

Application/Control Number: 10/022,874

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June 6, 2003

A handwritten signature in black ink, appearing to read 'J Fan', with a large loop at the beginning.

JANE FAN  
PRIMARY EXAMINER  
GROUP 1200